

EXHIBIT B



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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC ODRICH,
KENNETH GREENBERG, JEROME A. LEGERTON,
CHARLES R. MUNNERLYN, and JOHN K. SHIMMICK

Appeal 2008-1260
Application 10/600,027
Technology Center 3700

Decided: October 30, 2008

Before ERIC GRIMES, LORA M. GREEN, and FRANCISCO C. PRATS,
Administrative Patent Judges.

PRATS, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered May 21, 2008 (“Decision”), affirming the rejection of claims 10-15 for obviousness. The request for rehearing is denied.

DISCUSSION

Appellants argue that rehearing is appropriate because briefing was completed before the Supreme Court rendered its opinion in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), and because:

1. The Board appears to have misapprehended or overlooked the scope and content of the prior art, in particular, differences between the prior art and the claimed invention. This appears to be a misapprehension as the Board appears to have agreed with Appellants that the prior art does not teach each element of the claimed invention as recited in claim 10 and yet found claims 10-19 obvious in view of the prior art (e.g., Decision, p. 18-19).
2. The Board appears to have misapprehended or overlooked proper application of the *KSR* decision in using “common sense” alone to supply a claim element that is wholly missing from the prior art.
3. The Board appears to have misapprehended or overlooked what a skilled artisan at the time of the invention having “common sense” and/or ordinary creativity would, in fact, have reasonably inferred from the teachings of the prior art. There is no evidence or prior art present in the record, and cited by either the Board or the Examiner, to support modifying the combination of Frey and Largent to supply a missing element through inference or “common sense.”
4. The Board appears to have misapprehended or overlooked the requirement that a conclusion of obviousness be supported by some articulated reasoning with some rational underpinning.

(Req. Reh'g 2-3.)

ISSUE 1

Appellants argue that in affirming the Examiner's obviousness rejection of claims 10-15 over Frey and Largent our decision

misapprehended or overlooked the scope and content of the prior art because, even in combination, those references do not meet the limitation in claim 10 requiring the system to have a tangible medium with stored instructions that, if executed, cause the processor to “determin[e] the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, wherein the distribution is determined in response to a signal related to a size of the patient’s pupil” (Req. Reh’g 3).

We are not persuaded by this argument. In evaluating the Examiner’s conclusion of obviousness, our decision acknowledged that Frey’s pupil size-based vision-correcting system differed from claim 10 in that it did “not have instructions controlling the laser’s pulses such that the cornea is ablated to achieve a multifocal shape that corrects near and far vision” (Decision 16).

However, in view of Largent’s teaching of the desirability of using ablative laser energy to reshape a patient’s cornea to have one region shaped to correct near vision, and another region to correct far vision, we agreed with the Examiner that one of ordinary skill in the art would have been prompted to include in Frey’s vision correcting system instructions directing the processor to determine the distribution of the laser’s pulses so as to provide separate regions on the cornea to correct near and far vision, in the manner recited in claim 10 (*id.*; *see also* Decision 19). We therefore do not agree with Appellants that our decision overlooked or misapprehended the scope and content of the prior art vis-à-vis claim 10.

Seeking to refine their arguments, Appellants submit illustrations A, B, and, C, and refer to the Specification’s disclosure of the equation used to adjust the distribution of laser pulses, as evidence of what claim 10

encompasses, and what the prior art would have suggested to one of ordinary skill (*see* Req. Reh'g 4-9). However, those arguments were not submitted in the briefs filed in this appeal.

As stated in 37 C.F.R. § 41.52(a)(1), “[a]rguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.” Because Appellants have not pointed out why the new arguments fall into the exceptions in 37 C.F.R. § 41.52(a)(2) and (a)(3), we decline to consider them.

ISSUE 2

Appellants argue that our decision “does not dispute Appellant’s contention that the combination of Frey and Largent would not teach each element of claim 10, but instead appears to substitute ‘ordinary creativity and common sense,’ rather than the teaching in the prior art, to supply the missing elements” (Req. Reh’g 10 (quoting Decision 19)). Therefore, Appellants argue, our decision misinterprets or misapprehends the Supreme Court’s opinion in *KSR*, because *KSR* “simply does not support the proposition that a factfinder need not find precise teachings of claim elements, either in cited references or elsewhere in the art, when evaluating whether a claimed invention would be non-obvious” (Req. Reh’g 10). Rather, Appellants argue, “*KSR*, including the quoted provision, supports the more modest proposition that one need not seek out precise teachings when determining whether there would be a motivation to combine elements that have already been identified as being known in the prior art” (*id.*).

We do not agree with Appellants' characterization of our decision, nor do we agree that our decision misapprehended or misapplied *KSR* in affirming the Examiner's obviousness rejection.

We do, however, agree with Appellants that "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

We also agree that, while the Supreme Court emphasized a flexible approach to the obviousness question in *KSR*, the Court nonetheless similarly noted that

it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements *in the way the claimed new invention does* . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR, 127 S. Ct. at 1741 (emphasis added); *see also id.* at 1740-41 (requiring a determination of "whether there was an apparent reason to combine the known elements *in the fashion claimed* by the patent at issue") (emphasis added).

However, we do not agree with Appellants that our decision demonstrates a reliance only on common sense to meet the claim limitation at issue. As noted above, our decision acknowledged that Frey's pupil size-based vision-correcting system differed from claim 10 in that it did "not have instructions controlling the laser's pulses such that the cornea is ablated

to achieve a multifocal shape that corrects near and far vision” (Decision 16).

However, because Largent teaches the desirability of using ablative laser energy to reshape a patient’s cornea so that one region is reshaped to correct near vision, and another region is reshaped to correct far vision, we agreed with the Examiner that one of ordinary skill in the art would have been prompted to include in Frey’s vision-correcting system instructions directing the processor to determine the distribution of the laser’s pulses so as to provide separate regions on the cornea to correct near and far vision, in the manner recited in claim 10 (*id.*; *see also* Decision 19).

Thus, rather than relying solely on common sense, our decision to affirm the Examiner’s conclusion of obviousness relied on the knowledge imparted to one of ordinary skill by Largent and Frey. We therefore do not agree with Appellants that our decision reflects a misapprehension of the *KSR* opinion, or that our decision uses only common sense to teach or suggest a claim limitation.

ISSUE 3

Appellants argue that even if one assumes for argument’s sake that a person of ordinary skill would have sought “to combine the references so as to employ the pupil matching of Frey to the multi-region ablation shape of Largent, common sense would simply direct a skilled artisan to adjust the outer periphery of the ablation region and any accompanying change in ablation depth, not the inner ablation region” (Req. Reh’g 13). Thus, Appellants argue, “the idea of first combining the references and then further modifying the teachings by adjusting inner ablation regions of the Largent

correction in response to pupil size would not be supported by a common sense reading of the references” (*id.* at 14).

Appellants’ arguments do not persuade us that our decision misapprehended or overlooked any point of fact or law. Claim 10 does not recite “adjusting inner ablation regions.”

Rather, claim 10 recites a system for treating a cornea of an eye of a patient to mitigate presbyopia with a multifocal ablation shape. The system of claim 10 has a laser for making a beam of an ablative light energy, a processor in electrical communication with the laser, and a tangible medium coupled to the processor that has stored instructions (Decision 11 (Finding of Fact (“FF”) 5)).

The limitation in claim 10 at issue requires the stored instructions to cause the processor to:

determin[e] the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, where the distribution is determined in response to a signal related to a size of the pupil so as to balance the near vision correction and the far vision correction of the multifocal treatment for the patient.

As we articulated in our decision, Frey’s system includes a processor that meets the structural limitations of claim 10, as well as the limitation requiring the distribution of the corrective laser pulses to be determined in response to a signal related to a size of the pupil (*see* Decision 12-13 (FF 6-9)). Because Largent teaches the desirability of using ablative laser energy to reshape a patient’s cornea so that one region is shaped to correct near vision, and another region to correct far vision, we agreed with the Examiner that one of ordinary skill in the art would have been prompted to include in

Frey's pupil size-based vision-correcting system instructions directing the processor to determine the distribution of the laser's pulses so as to provide separate regions on the cornea to correct near and far vision (*see* Decision 16, 19). We therefore do not agree with Appellants that our decision misapprehended any point of law or fact with respect to this issue.

Appellants again seek to refine the arguments made in the briefs regarding the scope of claim 10 by referring to newly submitted illustrations B and C, and by referring to the Specification's disclosure of the parameters used to adjust the distribution of laser pulses (*see* Req. Reh'g 13-15). However, as discussed above, those arguments were not submitted in the briefs filed in this appeal. Because Appellants have not pointed out why the new arguments fall into either exception (a)(2) or (a)(3) of 37 C.F.R. § 41.52(a)(1), we decline to consider them.

ISSUE 4

Appellants argue:

[T]he Board appears to have either misapprehended or overlooked the requirement that, in order to establish a *prima facie* case of obviousness, the Examiner must set forth some articulated reasoning or logical rationale supporting a proposed combination of prior art and the resulting conclusion of obviousness. Such a requirement is clearly expressed in the recent *KSR* decision.

(Req. Reh'g 16.)

Specifically, Appellants take issue with our statement that "Appellants do not point to, nor do we see, any evidence that Frey's system would not have been adaptable to Largent's process" (*id.* at 17 (quoting Decision 20)). Appellants urge that this comment improperly "place[s] the burden of proving non-obviousness upon Applicant" (Req. Reh'g 17).

We are not persuaded by these arguments. We note that “‘rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.’” *KSR*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006) (emphasis added).

In the instant case, however, the Examiner explicitly stated that one of ordinary skill would have considered it obvious to use Frey’s device on a presbyopic subject,

since this condition is correctable with laser sculpture as taught by Largent, or to employ the pupil scaling device of Frey in the presbyopia treating system of Largent, since this would reduce the halo effect and improve night vision, as taught by Frey, thus producing a device such as claimed.

(Decision 10-11 (quoting Ans. 4)). We therefore do not agree with Appellants that the Examiner failed to adequately state the rationale underlying the obviousness conclusion.

As to the comment on page 20 of the decision, Appellants have taken the statement out of context. As the decision points out, Appellants argued that Largent’s ablation process “would not easily be adaptable for scaling of the outer periphery of the ablation shape, as taught by Frey” (Decision 20 (quoting App. Br. 14)). Thus, the statement that “Appellants do not point to, nor do we see, any evidence that Frey’s system would not have been adaptable to Largent’s process” (Decision 20) merely points out that Appellants had not explained where one could find evidence supporting the assertion regarding the lack of adaptability of Largent’s process to Frey’s

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system. We therefore do not agree with Appellants that the decision improperly placed the burden of showing non-obviousness on Appellants.

SUMMARY

Appellants' arguments do not persuade us that our decision affirming the Examiner's obviousness rejection of claims 10-15 has misapprehended or overlooked any point of fact or law. We therefore decline to modify our original decision entered May 21, 2008.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REHEARING DENIED

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